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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/604,769	08/14/2003	Liang-Fang Chen	ACMP0108USA	1768
27765	7590	06/01/2005	EXAMINER	
NORTH AMERICA INTERNATIONAL PATENT OFFICE (NAIPC) P.O. BOX 506 MERRIFIELD, VA 22116			STEIN, JULIE E	
			ART UNIT	PAPER NUMBER
			2685	

DATE MAILED: 06/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/604,769	<b>Applicant(s)</b> CHEN, LIANG-FANG	
	<b>Examiner</b> Julie E. Stein, Esq.	<b>Art Unit</b> 2685	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-4 and 9-11 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application Publication 2002/0077128 to Okun et al.

Okun discloses all the steps of independent claim 1 and dependent claim 4, including a method of handling a telephone call received by a first telephone system (called party) receiving a telephone call from a second telephone system (calling party), determining if the second telephone system is capable of receiving data messages in response to receiving the telephone call (paragraph 20), and the first telephone system sending a data message to the second telephone system in response to determining that the second telephone system is capable of receiving data messages (Id.), wherein the data message is a textual message (paragraph 20).

Okun also discloses all the steps of dependent claim 2, including wherein determining if the second telephone system is capable of receiving data messages comprises the first telephone system successfully identifying a telephone number (calling party terminal ID) of the second telephone system. See paragraph 20.

Okun discloses all the steps of dependent claim 3, including the first telephone system completing the telephone call with the second telephone system to accept voice data for a mailbox of the first telephone system in response to determining that the second telephone system is not capable of receiving data messages. See paragraph 45.

Okun discloses all the steps of dependent claim 9, including wherein the first telephone system comprises a mobile telephone and a base station, and the base station determines if the second telephone system is capable of receiving data messages. See paragraph 20, in which a subscriber profile is examined to determine the second telephone system capabilities and an HLR is given as an example. It would be inherent that a mobile telephone and a corresponding base station would be used to determine the capabilities in communication with the HLR.

Okun discloses all the steps of dependent claim 10, including the base station connecting the telephone call with a voice mailbox of the mobile telephone in response to determining that the second telephone system is not capable of receiving data messages. See paragraph 20 and 45 and discussion of inherency above.

Okun discloses all the steps of dependent claim 11, including wherein determining if the second telephone system is capable of receiving data messages comprises determining if a user device originating the telephone call in the second telephone system is capable of accepting data messages. See paragraph 20.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okun in view of U.S. Patent Application Publication No. 2004/0203945 to Qu et al.

Okun teaches all the steps of dependent claims 5-8, except wherein the data messages are video messages, SMS, EMS, or MMS. However, Qu teaches that all these types of messages are well known and are used with various message services. See paragraphs 4 and 5. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to include the capability to respond to the second telephone system with various types of data messages including video, SMS, EMS, and MMS, because all are well known type of messages that allow for varying types of messaging such as audio, video, animation, and the like. See Qu, paragraphs 4 and 5.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julie E. Stein, Esq. whose telephone number is (571) 272-7897. The examiner can normally be reached on M-F (8:30 am-5:00 pm).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Urban can be reached on (571) 272-7899. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JES

Nguyen Vo  
5-26-2005

NGUYENT.VO  
PRIMARY EXAMINER